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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,378	12/17/2003	Francisco Javier Canada Vicinay	2798-1-001	7275

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EXAMINER

UNDERDAHL, THANE E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



**Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group	Claims	Drawn to	Class/Subclass
I*	1-38	Process of making 4-O- $\beta$ -D-galactopyranosyl-D-xylose	435/41
II	39-41	The product 4-O- $\beta$ -D-galactopyranosyl-D-xylose	435/41
III	42-44	Use of 4-O- $\beta$ -D-galactopyranosyl-D-xylose	435/7.72

\*Species election required if this group is selected

The inventions are distinct, each from the other because of the following reasons:

**PRODUCT AND MAKING**

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, 4-O- $\beta$ -D-galactopyranosyl-D-xylose can be made by a materially different process as taught by Rivera-Sagredo et al. (Carbohydrate Research, Volume 228(1) 1992, see Abstract).

**PRODUCT AND USE**

Inventions I, II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

Art Unit: 1651

process of using that product. See MPEP § 806.05(h). In the instant case, as already mentioned above, the product in Group II can be made by a materially different method not related to Group I, so the method in Group III can use the product taught by Rivera-Sagredo et al. (Carbohydrate Research, Volume 228(1) 1992, Pg 129-135, see Abstract) instead of the product of group II that is produce in Group I.

#### REASON FOR RESTRICTION

The several inventions listed above are independent and distinct from one another as they have acquired a separate status in the art and require independent searches, particularly with regard to the literature searches. Clearly, a reference which would anticipate one of the above groups would not necessarily anticipate or even make obvious any of the others.

An undue burden would ensue from the examination of multiple methods which have distinct steps and end points. Burden lies not only in the search of US Patents, but in the search for literature and foreign patents and examination of the claim language and specification for compliance with the statutes concerning new matter, and distinctness.

#### ELECTION OF SPECIES

In addition if Group I is elected, a further election of species must be made.

This application contains claims directed to the following patentably distinct species:

Art Unit: 1651

Groups	Claims	Species to Elect
I	1, Step 3	Means to deactivate the $\beta$ -D-galactosidase:freezing, heating or filtering
I	1, Step 5	Solvent mixtures of acetone/methanol or acetone water
I	7	Type of filtration column listed in claim 7
I	36	Type of $\beta$ -D-galactopiranoside substrate: o-nitrophenyl $\beta$ -D-galactopiranoside or lactose
I	37 and 38	$\beta$ -D-galactosidase source: E. Coli or Kluyveramyces lactis

The species are independent or distinct because they do not belong to any art recognized group nor do they share a substantial structural feature.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim or claim X is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and **a listing of all claims readable thereon**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the

Art Unit: 1651

election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

#### MULTIPLE INVENTORS

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### OCHIAI

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection

Art Unit: 1651

are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

## CONCLUSION

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be

Art Unit: 1651

traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

#### CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thane Underdahl whose telephone number is (571) 272-9042. The examiner can normally be reached during regular business hours, 8:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926. The fax phone

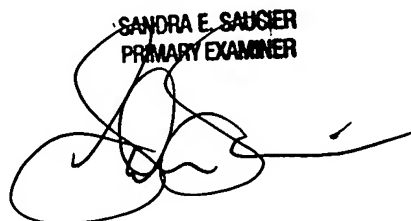
Art Unit: 1651

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 1651



SANDRA E. SAUGIER  
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